Supreme Court, U. S.
FILED
JAN 19 1979
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1978

No. 78-1149

JAMESBURY CORPORATION,

Respondent,

v.

LITTON INDUSTRIAL PRODUCTS, INC.,

Petitioner.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

JOHN A. DIAZ
Attorney for Petitioner
345 Park Avenue
New York, New York 10022

Of Counsel:

MORGAN, FINNEGAN, PINE, FOLEY & LEE
J. ROBERT DAILEY
345 Park Avenue
New York, New York 10022

GROSS, HYDE & WILLIAMS
THOMAS F. PARKER
799 Main Street
Hartford, Connecticut 06103

January 21, 1979

TABLE OF CONTENTS

PAGE

Opinions Below 1

Jurisdiction 2

The Question Presented 2

Constitutional Provisions and Statutes Involved 3

Statement of the Case 3

Argument

Reason for Granting the Writ

1. A Conflict Among the Circuits Exists 6
2. The Rule Against Patent Overclaiming Protects the Public from an Inventor Who Claims More Than He Invented 6
3. The Public Policy Underlying the Patent Laws Requires that the Second Circuit's Interpretation of the Doctrine of Patent Overclaiming Be Reversed 9
4. Conclusion 11

Appendix A1

TABLE OF AUTHORITIES

PAGE

Cases:

Deep South Packing Co. v. Laitram Corp., 406 U.S. 518 (1972) 10

Duplan Corp. v. Deering-Milliken, Inc., 444 F. Supp. 648 (D.S.C. 1977) 5, 6, 8

Evans v. Eaton, 20 U.S. 356 (1822) 5, 6, 7, 9

Graham v. John Deere, 383 U.S. 1 (1966) 10

Holstensson v. V-M Corp., 325 F.2d 109 (6th Cir. 1963) 5, 8

Jamesbury Corp. v. United States, 518 F.2d 1384 (Ct. Cl. 1975) 4

Jamesbury Corp. v. Worcester Valve, Inc., 318 F. Supp. 1 (D. Mass. 1970) 3

Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545 (1938) 5, 7, 8

Morton Salt v. G. S. Suppiger Co., 314 U.S. 488 (1942) 6

Parker v. Flook, 46 U.S. L.W. 4791 (1978) 10

Williams Mfg. Co. v. United Shoe Machinery Corp., 121 F.2d 273 ..... 5, 7

Statutes:

28 U.S.C. §1254(1) 2

28 U.S.C. §1338(a) 2

Other Authorities:

Constitution, Article 1, Section 8, Clause 8 3

IN THE

Supreme Court of the United States

October Term, 1978

No. ——

JAMESBURY CORPORATION,

Respondent,

v.

LITTON INDUSTRIAL PRODUCTS, INC.,

Petitioner.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit in the above-entitled case.

Opinions Below

In its Complaint respondent Jamesbury Corporation ("Jamesbury") accused petitioner Litton Industrial Products, Inc. ("Litton") of direct infringement of Claims 7 and 8 of U.S. Patent No. 2,945,666, which expired on July 19, 1977.

On November 18, 1977, the Honorable M. Joseph Blumenfeld, United States District Judge for the District of Connecticut, applied the doctrine of patent overclaiming and granted petitioner's Motion for Summary Judgment of Patent Invalidity based thereon. Judge Blumenfeld's opinion is reported at 442 F. Supp. 266 and is reproduced in the Appendix, A1 to A5.

On October 23, 1978, the Second Circuit Court of Appeals reversed "on the law." The decision of the Second Circuit Court of Appeals is reported unofficially at 199 U.S.P.Q. 641 and reproduced in the Appendix, A6 to A21.

Jurisdiction

Jurisdiction to review the judgment below by writ of certiorari is conferred by 28 U.S.C. §1254(1). Jurisdiction of the Trial Court was based upon 28 U.S.C. §1338(a).

The Question Presented

Should this Court resolve the conflict among the Circuits as to whether the doctrine of patent overclaiming applies to cases of direct infringement as well as cases of contributory infringement?

The rule in the Sixth Circuit is that application of the doctrine of patent overclaiming *does not* depend on the nature of the claimed infringement, i.e., it applies to cases of direct as well as contributory infringement. The rule in the Second Circuit is that application of the doctrine of patent overclaiming *does* depend on the nature of the claimed infringement, i.e., it is limited to cases of contributory infringement and should not be expanded to cases of direct infringement.

The rule in the Sixth Circuit is followed by courts in the Fourth Circuit. The rule in the Second Circuit is apparently followed by the Court of Claims. Jamesbury advised the Court below that if the Sixth Circuit rule applied, thousands of patents issued by the U.S. Patent Office might be invalid. Thus, the question presented is one of overriding public importance and this Court should resolve the basic conflict among the Circuits thereon.

Constitutional Provisions and Statutes Involved

The limited issue raised by this petition is the proper scope to be accorded the doctrine of patent overclaiming which is based upon the Constitution, Article 1, Section 8, Clause 8:

> "The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Statement of the Case

The patent in suit is directed to a ball valve comprising three parts: (1) a casing; (2) a ball; and (3) a valve seat, also referred to as a sealing ring. It stands admitted that ball valves comprising a casing, a ball and a valve seat have been known for over fifty (50) years.

In *Jamesbury Corp.* v. *Worcester Valve, Inc.*, 318 F. Supp. 1 (D. Mass. 1970), *aff'd*, 443 F.2d 205 (1st Cir. 1971),

the Court found that the "essence" of the invention of the patent here in suit resided in the improved valve seat (318 F.Supp. at 5), and in *Jamesbury Corp.* v. *United States,* 518 F.2d 1384 (Ct. Cl. 1975), the Court found that the patented ball valve employs "a novel sealing ring" (518 F.2d at 1387). Like Judge Blumenfeld (App. A3), Litton assumes that the sealing ring is inventive.

The patent in suit states that both the ball and the valve casing are "conventional" and that the valve seat is improved (App. A3). At the hearing before Judge Blumenfeld on October 11, 1977, Jamesbury admitted that: "The only thing that's new is the seat." Nevertheless, Jamesbury insisted that it was entitled to a patent on "the whole works."

> "Mr. Neustadt [Counsel for Jamesbury]: The defendant's statement that Judge Garrity [in *Jamesbury Corp.* v. *Worcester Valve Co.*] found the essence of the invention to be the valve seat is really nothing more than the patentee said in his patent. He said that the casing is old and he also said that the ball is old. The only thing that's new is the seat. And that's what Judge Garrity said by saying, well, the essence of the invention is the seat.
>
> "The Court: All right. Now so that I'll get it straight, I guess, you do claim that the whole valve as set forth in—I don't know, claim 7 or claim 8?
>
> "Mr. Neustadt: Yes, your Honor.
>
> "The Court: You do claim it. So it isn't a question now of my having to decide that you don't claim it; that, in effect, all you claim is the seal.
>
> "Mr. Neustadt: That's correct, your Honor.
>
> "The Court: You claim the whole works.
>
> "Mr. Neustadt: Yes, sir."

Judge Blumenfeld, relying upon *Lincoln Engineering Co.* v. *Stewart-Warner Corp.,* 303 U.S. 545, 549-550 (1938), held Claims 7 and 8, on "the whole works," to be invalid for overclaiming. In so doing he expressly adopted *Williams Mfg. Co.* v. *United Shoe Mach. Corp.,* 121 F.2d 273 (6th Cir. 1941), *aff'd,* 316 U.S. 364 (1942) and *Holstensson* v. *V-M Corp.,* 325 F.2d 109 (6th Cir. 1963), *cert. denied,* 377 U.S. 966 (1964), both of which applied the doctrine of patent overclaiming in cases of direct infringement and held patents invalid for overclaiming.

The Second Circuit recognized that if it "were to apply the premise of the District Court," i.e., that *Lincoln Engineering* applied, then Judge Blumenfeld's reasoning "would be unassailable" and the patent in suit would be invalid as a matter of law (App. A14). The Second Circuit, however, refused to apply *Lincoln Engineering* to this case of direct infringement and reversed "on the law" (App. A6).

In its reversal, the Second Circuit completely ignored *Evans* v. *Eaton,* 20 U.S. 356 (1822), which was briefed to the Court by petitioner. In *Evans* v. *Eaton* this Court more than 150 years ago applied the doctrine of patent overclaiming to invalidate a patent in a case of direct infringement.

In its reversal the Second Circuit also ignored *Duplan Corp.* v. *Deering-Milliken, Inc.,* 444 F. Supp. 648 (D.S.C. 1977), also briefed to the Court by petitioner. In *Duplan,* the Court also applied the doctrine of patent overclaiming to invalidate a patent in a case of direct infringement.

It should be noted that the same patent firm represents both the patentee in *Duplan* and the alleged infringer here.

And yet in *Duplan* the Court held the patent invalid, ruling that the doctrine of patent overclaiming was not limited to cases of contributory infringement, whereas the Court here reversed a holding of invalidity, ruling that the doctrine of patent overclaiming is limited to cases of contributory infringement.

ARGUMENT

Reason for Granting the Writ

1. A Conflict Among the Circuits Exists.

The Sixth Circuit rule, followed by courts of the Fourth Circuit, is that application of the doctrine of patent overclaiming *does not* depend on the nature of the claimed infringement. The Second Circuit rule, apparently followed by the Court of Claims, is that application of the doctrine of patent overclaiming *does* depend on the nature of the claimed infringement.

This Court has traditionally granted certiorari to resolve a conflict among the Circuits on a question of public importance which has not been but should be settled by this Court. *Morton Salt* v. *G. S. Suppiger Co.*, 314 U.S. 488, 490 (1942).

2. The Rule Against Patent Overclaiming Protects the Public from an Inventor Who Claims More Than He Invented.

The rule against overclaiming goes back more than a century and a half to *Evans* v. *Eaton, supra,* a case of direct infringement. There the patent related to a device called a "Hopperboy" which was employed in the manufacture of flour. Although the patentee had improved one part of the

machine, he nevertheless claimed the whole machine. This Court held the patent invalid, stating:

> ". . . If the same combination existed before in machines of the same nature, up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of operation, to the old, the patent should be limited to such improvement, for if it includes the whole machinery, it includes more than his invention, and therefore cannot be supported. . . ." (20 U.S. at 430-31).

Lincoln Engineering Co. v. *Stewart-Warner Corp., supra,* was an action for contributory infringement of a patent on a device for lubricating automobile bearings. Lubricating devices comprising the combination of a grease pump, a hose, a coupler and a fitting connected to the bearing to be lubricated were old (303 U.S. at 547). Although the patentee had improved the coupler (303 U.S. at 549), the claims were not limited to the improvement. This Court invalidated the patent, holding that it was "void as claiming more than the applicant invented" (*Ibid.*).

Williams Mfg. Co. v. *United Shoe Mach. Corp., supra,* was a case of direct infringement involving two patents (121 F.2d at 274). The Sixth Circuit applied the doctrine of overclaiming and invalidated one of the patents while sustaining the second patent over that same defense. This Court affirmed the ruling with respect to the second patent, holding that although the patentee had recited in his claim the environment of "mechanical parts" in which the improvement was to operate, he did not "purport to embody them as elements of the claimed combination" (316 U.S. at 369).

In *Holstensson* v. *V-M Corp., supra,* also a case of direct infringement, the Sixth Circuit refused to limit the doctrine of patent overclaiming to cases of contributory infringement and invalidated the patent (325 F.2d at 122).

In *Duplan* v. *Deering-Milliken, supra,* also a case of direct infringement, the Court rejected the contention that the doctrine of patent overclaiming was limited to cases of contributory infringement and invalidated the patent.

> "Defendant's attempt to distinguish Lincoln Engineering on the grounds that it invloved a suit for contributory infringement is rejected." (444 F. Supp. at 716).

In reversing Judge Blumenfeld, the Second Circuit acknowledged *Lincoln Engineering* but refused to apply it to this case of direct infringement. Instead, it adopted Jamesbury's argument that the application of the doctrine of patent overclaiming depends on the nature of the claimed infringement and reversed "on the law" (App. A6).

> ". . . A claim for direct infringement would lie *only* against one who infringes a ball valve containing the specified sealing ring. *Guide* v. *Desperak, supra,* 249 F.2d at 147.
>
> "Of course, that limitation might not apply to a *contributory* infringer, who manufactured a conventional valve or ball which the direct infringer then combined with an infringing sealing ring to make an entire infringing device. If such a contributory infringer were to be held liable, there would be an argument on policy that the claim was unfairly overbroad. We are not dealing here with such a contributory infringer, and older cases, including *Lincoln Engineering, supra,* in which *contributory* infringers were suppliers of conventional elements, must be read with that distinction in mind. When we juxtapose *Williams, supra,* a direct infringement case, with *Lincoln Engineering,* one gets the impression that the nature of the claimed infringement, though not the sole basis for decision, substantially affected the result. We need not go so far as the Patent and Trademark Board of Appeals has gone in ruling that, since it is now a defense to contributory infringement that a product is capable of substantial non-infringing use, 35 U.S.C. §271(c), statutory amendments may have deprived *Lincoln Engineering* of force on its own ground. *Ex parte Barber,* 187 U.S.P.Q. (BNA) 244 (1974). We find it unnecessary to determine whether we agree with the suggestion in that opinion that *Lincoln Engineering* has been legislatively overruled, but we do find that subsequent history militates against an expansive application of the Court's reasoning in *Lincoln Engineering.*" (Emphasis in original) [App. A20-A21].

Thus, the Second Circuit refrained from ruling that the doctrine of patent overclaiming had been legislated completely out of existence, as was urged below by Jamesbury, it being sufficient for a reversal to hold that it did not extend to cases of direct infringement.

3. The Public Policy Underlying the Patent Laws Requires that the Second Circuit's Interpretation of the Doctrine of Patent Overclaiming Be Reversed.

The Sixth Circuit's holding that the doctrine of patent overclaiming is applicable to cases of direct as well as contributory infringement is based upon more than 150 years of judicial precedent dating back to the direct infringement case of *Evans* v. *Eaton,* decided by this Court

in 1822. That decision recognizes that a patent which claims more than the patentee invented is void.

The Sixth Circuit's interpretation is consonant with the principles enunciated by this Court in *Graham* v. *John Deere,* 383 U.S. 1, 6 (1966):

> ". . . Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain or to restrict free access to materials already available. . . ."

The Sixth Circuit's interpretation is also consonant with this Court's holding in *Deep South Packing Co.* v. *Latrim Corp.,* 406 U.S. 518, 531 (1972):

> ". . . [W]e should not expand patent rights by overruling or modifying our prior cases construing the patent statutes unless the argument for expansion of privilege is based on more than mere inference from ambiguous statutory language. . . ."

Finally, the Sixth Circuit's interpretation is consonant with this Court's holding in *Parker* v. *Flook,* 46 U.S.L.W. 4791, 4794 (1978), that the patent statutes must be construed as they now read in light of this Court's prior decisions.

As brought out *supra,* the doctrine of patent overclaiming was first enunciated by this Court more than 150 years ago in *Evans* v. *Eaton,* a case of direct infringement. Since then, neither Congress nor this Court has ever decided that the application of the doctrine of patent overclaiming depends on the nature of the claimed infringement and the Second Circuit's holding to the contrary is in error.

4. Conclusion

Under the Sixth Circuit rule the defense of patent invalidity for overclaiming does not depend on the nature of the claimed infringement and is available in cases of both direct and contributory infringement.

Under the Second Circuit rule the application of the defense of patent invalidity for overclaiming depends on the nature of the claimed infringement, is limited to cases of contributory infringement, and cannot be expanded to cases of direct infringement.

The Second Circuit's holding that the *validity* of a patent depends on the nature of the claimed *infringement* finds no support either in logic or in law and should not be permitted to stand.

January 21, 1979

Respectfully submitted,

JOHN A. DIAZ
Attorney for Petitioner
345 Park Avenue
New York, New York 10022

Of Counsel:

MORGAN, FINNEGAN, PINE, FOLEY & LEE
J. ROBERT DAILEY
345 Park Avenue
New York, New York 10022

GROSS, HYDE & WILLIAMS
THOMAS F. PARKER
799 Main Street
Hartford, Connecticut 06103

APPENDIX

JAMESBURY CORP.

v.

LITTON INDUSTRIAL PRODUCTS, INC.

Civ. No. H-76-79.

United States District Court, D. Connecticut.

Nov. 28, 1977.

As Amended Dec. 2, 1977.

Action was brought for alleged infringement of patent. The District Court, Blumenfeld, J., held that: (1) claims 7 and 8 of patent No. 2,945,666 which claimed a ball valve, and not only a new sealing ring, were invalid for overclaiming, and (2) although, viewed abstractly, it would have been possible to make a case that claims were capable of a narrow construction if read in light of specifications, such freedom to use the specifications to rescue unambiguous claims, held invalid for overclaiming, was not permissible.

Judgment for defendant.

1. Patents ⇐327(11)

Fact that patent in issue had been previously held valid did not dispose of subsequent infringement action defended on ground of overclaiming, since overclaiming had been neither raised nor litigated in prior action.

2. Patents ⇐328(2)

Claims 7 and 8 of patent No. 2,945,666 which claimed a ball valve, and not only a new sealing ring, were invalid for overclaiming.

3. Patents ⇐167(1¼)

Although, viewed abstractly, it would have been possible to make a case that claims were capable of a narrow construction if read in light of specifications, such freedom to use the specifications to rescue unambiguous claims, held invalid for overclaiming, was not permissible. 35 U.S.C.A. § 112.

J. Read Murphy, Murtha, Cullina, Richter & Pinney, Hartford, Conn., Robert C. Miller, Oblon, Fisher, Spivak, McClelland & Maier, Arlington, Va., for plaintiff.

Thomas F. Parker, Gross, Hyde & Williams, William A. Taylor, Hartford, Conn., John A. Diaz, Morgan, Finnegan, Pine, Foley & Lee, J. Robert Dailey, New York City, for defendant.

RULING ON MOTION FOR SUMMARY JUDGMENT

BLUMENFELD, District Judge.

This is an action for alleged infringement of U.S. Patent No. 2,945,666 entitled "Ball Valve." The patent issued on July 19, 1960, and expired on July 19, 1977. The patent has been the subject of active litigation since 1963.[1] The Court of Claims upheld the validity of claims 7 and 8,[2] which the defendant is accused of infringing, *Jamesbury Corp. v. United States*, 518 F.2d 1384,

1. The issue of ownership of the patent, as distinguished from validity, was decided in favor of Jamesbury Corp. in *Jamesbury Corp. v. Worcester Valve Co.*, 318 F.Supp. 1 (D.Mass. 1970), *aff'd*, 443 F.2d 205 (1st Cir. 1971).

2. These claims are as follows:

"7. A ball valve comprising: a casing adapted to be connected to a pipe line and having a valve chamber and inlet and outlet openings; a ball mounted in said chamber and having a port; and a sealing ring mounted in said chamber around one of said openings, said ring having a lip projecting inward toward the axis of the ring and engaging the ball, said lip being free to bend in the axial direction of the ring and increasing in thickness outward in the radial direction of the ring, and said ball being rotatable between an open position in which said port is in register with the opening surrounded by said ring and a closed position.

"8. A ball valve as described in claim 7, said lip having side faces disposed one toward the ball and one away from the ball, and said faces diverging from each other substantially uniformly outward in the radial direction of the ring."

A 2

207 Ct.Cl. 516 (1975), against a challenge that they failed to meet the requirements of patentability set forth in 35 U.S.C. § 103.[3]

The defendant in this case, however, moves for summary judgment on the ground that claims 7 and 8 are invalid for overclaiming.

I.

[1] The fact that the '666 patent has been previously held valid does not serve to dispose of this action, for the defense of overclaiming was neither raised nor litigated. *Holstensson v. V–M Corp.*, 325 F.2d 109 (6th Cir. 1963), *cert. denied*, 377 U.S. 966, 84 S.Ct. 1646, 12 L.Ed.2d 736 (1964) is instructive on this point. The patent at issue in *Holstensson* had previously been held valid in *Holstensson v. Webcor, Inc.*, 150 F.Supp. 441 (N.D.Ill.1957). Following that decision everyone but V–M Corp. took a license under the patent. 325 F.2d at 119. The patent was again upheld in a suit for infringement against V–M, which raised an additional defense of overclaiming. The Court of Appeals reversed and held the patent invalid on the ground that the patentee had overclaimed.

II.

The same patent claims in issue here were viewed by the Court of Claims in *Jamesbury Corp. v. United States*, 518 F.2d 1384, 1387–88, 207 Ct.Cl. 516 (1975) as follows:

> "[C]laims 7 and 8 . . . define a ball valve comprising a casing, valve chamber having openings, a rotatable ball in the chamber and having a port, and a sealing ring mounted in the chamber around one of the openings, the sealing ring having a lip extending toward the axis of the ring and engaging the ball. Claims 7 and 8 define the lip as free to bend in the axial direction and increasing in thickness outward in the radial direction of the ring, which projects inwardly toward the axis of the sealing ring and sealingly contacts or engages the ball, and which is free to move in the axial direction of the sealing ring. Claim 8 further defines the lip as having one side face disposed toward the ball and one side face away from the ball, which faces diverge from each other substantially uniformly outward in the radial direction of the ring."

No defense of overclaiming was asserted in that case.

Reduced to simpler terms by the plaintiff in its brief, a ball valve consists of a casing, a sealing ring and a ball. The casing is hollow and has two ends, an inlet end to be connected to an inlet pipe and an outlet end to be connected to an outlet pipe. There is a bore in the ball, which may be rotated to permit fluid flow through the bore, or may rotate a quarter turn so as to block flow through the casing. The sealing ring, as the name implies, is a ring which seals and prevents leakage between the casing and the ball. Describing it even more simply, a ball valve is used to control the flow of liquid and gases in pipelines and is enclosed within a casing so adapted that it can be connected into the pipeline.

While the plaintiff professes "some surprise" at this defendant's motion so late in the day, that reaction is also surprising in view of the long-standing rule of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549–50, 58 S.Ct. 662, 665, 82 L.Ed. 1008 (1938) that "[t]he improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination."

There is nothing to indicate that a ball valve incorporating the new seal performs

3. 35 U.S.C. § 103 provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

any "additional or different function" than other ball valves. It does not function in a new manner. It may be more efficient or durable, but it does what ball valves have always done. *Cf. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 71 S.Ct. 127, 95 L.Ed. 162 (1950). Even the use of a seat/seal in a ball valve was not new. As the specifications indicate, the objective of the invention is an improved seal and seat. (Col. 1 *ll* 30–39). The patentee may have invented a seat and seal suitable for use in a ball valve, but there is not the slightest doubt that the plaintiff did not invent a ball valve.

The specifications, which teach how to practice the invention, *Application of Robertson*, 470 F.2d 1399, 1403 (C.C.P.A.1973) begin: "This invention relates to ball valves, and more particularly to sealing elements for the valve seat . . . ." (Col. 1 *ll* 15–16). They admit that the valve casing and the ball are conventional[4] and that "[t]he principal object of this invention is to produce a valve seat construction which provides maximum security against leakage, which reduces wear on the seats to a minimum and which ensures smooth opening and closing of the valves." (Col. 1 *ll* 30–34).

[2] Here, as in *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 121 F.2d 273, 279 (6th Cir. 1941), *aff'd*, 316 U.S. 364, 62 S.Ct. 1179, 86 L.Ed. 1537 (1942), "whatever improvement may result is due entirely to the improved element and cannot give rise to valid claims embracing the entire [ball valve] mechanism."

There cannot be any doubt that the plaintiff claims a ball valve, not only a sealing ring. Its brief contends, at page 5, "The operation of the Jamesbury ball valve and how this operation overcame the serious problems inherent in the unsuccessful prior art ball valves is succinctly set forth in the decision of the Court of Claims." A long extract from that opinion, 518 F.2d 1384, 1386–87, is then quoted to support the plaintiff's contention that it invented a ball valve. I excerpt only a few sentences from the extract on which plaintiff relies:

> "The patent in suit describes and claims an improved ball valve. . . .
>
> "Prior to the development of the plaintiff's patented valve, ball valves were not generally accepted or used by industry. . . .
>
> "The ball valve which is the subject matter of the patent in suit solved the problems of temperature variation, pressure variation, and valve wear. The patented ball valve employs a novel sealing ring utilizing a principle different from the compression sealing rings . . . ."

The plaintiff does not relinquish its contention that its patent embraces the entire ball valve, and that it is valid as a patent on a combination because it achieves an improved result. Resourceful as this contention may be, it cannot be twisted to mean that the sealing ring operates to make the valve perform a new *function*. *Lincoln Engineering, supra*.

III.

Although the plaintiff is reluctant to relinquish its claims, nevertheless it concedes: "This is not to say that a claim directed to only a sealing ring could not particularly point out and distinctly claim an invention . . . ." Plaintiff's Brief at 8. Even if the claims are broader than permissible, plaintiff seeks to preserve that portion of the claims which it could validly have made. This second, or fall-back, position asks the court to narrow the claim by trimming off its overly broad portion in order to salvage that portion which would be valid. In support of this it cites two cases, to which I now turn.

The Manual of Patent Examining Procedure, Section 706.03j, provides:

> The fact that an applicant has improved one element of a combination which may be *per se* patentable does not entitle him to a claim to the improved element in combination with old elements where the

4. The Specification, Col. 1 *ll* 40–43, states: "The valve here disclosed includes a ball, a valve casing, and a bonnet, all of which may be of generally conventional construction."

elements perform no new function in the combination.

In *Application of Bernhardt*, 417 F.2d 1395, 57 C.C.P.A. 737 (1969), the Court of Customs and Patent Appeals held that this language does not permit the Patent Office to reject such an "old combination" claim. The court held that a patent could only be rejected on the basis of 35 U.S.C. § 112, which requires that the applicant state "claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." It reasoned that if the applicant omitted to mention in its claims the combination in which an improved element was to be used (in this case, the ball valve), this would not make the claims more distinct; a recitation of the combination in the preamble would only lengthen it. It also concluded that without any mention of the combination, a broader monopoly would be claimed: in this case, protection would extend to valve seats whether or not used in ball valves. But the court specifically eschewed any concern "with the soundness of the underlying policy, if any, for old combination rejections." 417 F.2d at 1403.

[3] Although the scope of protection was not in issue in *Ex parte Barber*, 187 U.S.P.Q. (BNA) 244 (Pat. & Trademark Office Bd. of Appeals, 1974), the opinion commented favorably on *Bernhardt*. Two of the Examiners in Chief thought that *Lincoln Engineering*, *supra*, had been legislated out of existence. 187 U.S.P.Q. at 246. I am not about to accede to that view. I find the dissenting opinion in *Ex parte Barber*, which takes the opposite view, more persuasive. It may be that the Patent Office will change its procedural rule in Section 706.03j of the Manual. It is one thing to save an application for a patent from rejection because it claims too much, but it is quite another to permit the use of an overly broad patent against the public. The respect that others have for a patent after the Patent Office has endowed it with a presumption of validity enables the patentee to exact monopoly advantage until someone undertakes the expense of litigation. Viewed abstractly, it would be possible to make a case that the claim is capable of a narrow construction if read in light of the specifications. But such freedom to use the specifications to rescue these unambiguous claims is not permissible.

As the Court said in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 277, 69 S.Ct. 535, 539, 93 L.Ed. 672 (1949):

> "We have frequently held that it is the claim which measures the grant to the patentee. . . . While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. . . ." (citations omitted).

See also Trico Products Corp. v. Roberk Co., 369 F.Supp. 1146, 1155–56 (D.Conn.), *aff'd*, 490 F.2d 1280 (2d Cir. 1973) (without considering this ground), *cert. denied*, 417 U.S. 933, 94 S.Ct. 2645, 41 L.Ed.2d 236 (1974). Inventors desiring the maximum protection no doubt have a difficult task in defining their claims. But when they fail, as in this case, it is because, like the dog in the fable, they grasp too much, and so lose all. Where the public interest in patents is to be protected, the rule is the same as explained in *Holstensson v. V–M Corp.*, *supra*, 325 F.2d at 125:

> "It might appear unfair to deny an inventor the fruits of his invention merely because he overclaimed its breadth in his patent application and unjust to allow a third party to appropriate and infringe a true invention because of the failure of a patentee to comply with the patent statute. This might be arguable unless we look upon *Evans v. Eaton* [7 Wheat. 356, 20 U.S. 356, 5 L.Ed. 472] as announcing a policy which, correctly applied, may visit forfeiture of a patent even though it, in part, discloses true invention. That such is the thrust of the majority opinion in *Evans* is exposed by its dissenting

opinion which decries the severity of the rule of the majority opinion. The dissenter observes:

> 'To declare a patent for a highly useful improvement absolutely void, merely for a defective specification, if this be one, is a very high penalty, and should not be lightly inflicted unless rendered absolutely necessary by law.' (7 Wheat. 448, 20 U.S. 448, 5 L.Ed. 495).
>
> "In contemplating this seemingly drastic rule, we bear in mind that there is no natural or common law right to a monopoly of an invention. Robinson Treatise on the Law of Patents (1890) § 24. By Constitutional grant, Article I, § 8, Clause 8, Congress has power to give inventors, for a limited time, 'the exclusive right to their respective discoveries.' Applicants for such monopolies must comply with the requirements that Congress insists be met as a condition to exercising such monopoly. The seeming harshness of this rule is further ameliorated when we keep in mind that an inventor may gain monopoly for an inventive improvement to an existing device simply by limiting his claim to that which he did invent. In the case before us, this could have been accomplished by a narrowing of Claim 1, or by presentation of a separate claim limited to the spindle type record dropper which, for this opinion, it is assumed presented invention. In Sweden, Holstensson did this. Swedish patent No. 97,122 was taken out on the entire machine, while patent No. 97,123 was limited to the spindle record dropper. The same procedure could have been followed here, but was not."

There being no genuine issue as to any material fact, the defendant is entitled to judgment as a matter of law that claims 7 and 8 of the patent in issue are invalid. It is

SO ORDERED.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 6—August Term, 1978.

(Argued September 11, 1978 Decided October 23, 1978.)

Docket No. 78-7004

JAMESBURY CORPORATION,

Appellant,

—against—

LITTON INDUSTRIAL PRODUCTS, INC.,

Appellee.

B e f o r e :

OAKES, GURFEIN and MESKILL,

Circuit Judges.

Appeal from an order of summary judgment, dated November 30, 1977, of the United States District Court for the District of Connecticut (Hon. M. Joseph Blumenfeld, *Judge*), declaring as a matter of law that claims 7 and 8 of appellant's Patent No. 2,945,666, disclosing a ball valve in combination with a novel sealing ring, are invalid for overclaiming. Held, a combination claim with a single novel element, in which all the elements cooperate to produce an improved result, does not suffer from lack of patentability on the ground that it claims in excess of a valid patent monopoly.

Reversed on the law and remanded for further proceedings.

ARTHUR I. NEUSTADT, Arlington, Va. (Robert C. Miller and Oblon, Fisher, Spivak, McClelland & Maier, Arlington, Va., and J. Read Murphy and Murtha, Cullina, Richter & Pinney, Hartford, Conn., of counsel), *for Appellant.*

JOHN A. DIAZ, New York, N.Y. (J. Robert Dailey and Morgan, Finnegan, Pine, Foley & Lee, New York, N.Y., and Thomas F. Parker and Gross, Hyde & Williams, Hartford, Conn., of counsel), *for Appellee.*

GURFEIN, *Circuit Judge*:

This is an appeal from a summary judgment in favor of an alleged *direct* infringer in a patent infringement case. The issue on appeal is whether summary judgment was properly granted against the patentee on the ground that claims 7 and 8 of appellant's Patent No. 2,945,666. entitled "Ball Valve", are invalid for overclaiming. Having found the patent invalid for overclaiming, the District Court did not reach the question of novelty or obviousness, nor the question of whether there has been an infringement.[1]

The District Court of Connecticut (Hon. M. Joseph Blumenfeld, Judge) held the claims invalid on the authority of *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545 (1938), which we discuss below. We are called upon to interpret the test for patent overclaiming established by this precedent of a generation ago, and

1 The District Court granted summary judgment as a matter of law. The defendant moved for summary judgment on the basis that the patent is invalid on its face. It submitted no affidavit or other evidence in support of the motion.

to determine its applicability to the facts of the present case.

The patent claims involved in this case disclose a ball valve, comprised of a valve chamber, a ball, and a seat or seal.[2] The basic mechanism has been in use for at least fifty years,[3] though it has been found that "prior to the development of the plaintiff's patented valve, ball valves were not generally accepted or used by industry". *Jamesbury Corp.* v. *United States*, 518 F.2d 1384, 1386 (Ct. Cl. 1975). It is designed to control the flow of fluid in both directions through pipelines. The chamber has both an inlet and an outlet opening. The ball, which is mounted for rotation, has a passage bored through it. When the ball is rotated to an "open" position, the passage is aligned with the chamber openings, so as to permit flow. When rotated to a "closed" position, the passage is at a right angle to the chamber openings, and the surface of the ball operates to cut off flow. The seal or seat has two purposes. It holds the ball in place, and it seals the juncture between ball and chamber to prevent leakage. Two such seals are often employed, one on either side of the ball.[4]

---

2 The claims in issue read:

7. A ball valve comprising: a casing adapted to be connected to a pipe line and having a valve chamber and inlet and outlet openings; a ball mounted in said chamber and having a port; and a sealing ring mounted in said chamber around one of said openings, said ring having a lip projecting inward toward the axis of the ring and engaging the ball, said lip being free to bend in the axial direction of the ring and increasing in thickness outward in the radial direction of the ring, and said ball being rotatable between an open position in which said port is in register with the opening surrounded by said ring and a closed position.

8. A ball valve as described in claim 7, said lip having side faces disposed one toward the ball and one away from the ball, and said faces diverging from each other substantially uniformly outward in the radial direction of the ring.

3 Defendant-Appellee's Brief, at 3.

4 A somewhat more detailed description of ball valves may be found in *Jamesbury Corp.* v. *United States*, *supra*, 518 F.2d at 1386.

As the preamble to appellant's patent indicates,[5] the claimed novelty of its invention lies primarily in the seal. The patent is addressed to the "especially difficult sealing problem" occasioned by use of ball valves for handling corrosive or radioactive materials and fluids at high temperature in various industrial settings. The essence of

---

5 H.G. Freeman et al. Patent No. 2,945,666, Ball Valve (June 19, 1960), *reprinted in* Appendix, at 12. The preamble, portions of which are quoted in text, reads in full:

> This invention relates to ball valves, and more particularly to sealing elements for the valve seat, the present application being a continuation-in-part of copending application Serial No. 436,188, filed June 11, 1954, now abandoned. Ball valves for handling corrosive or radioactive materials and fluids at high temperature, present an especially difficult sealing problem. It is essential to form a perfectly tight seal between the ball and the seat, usually on both the upstream and the downstream side, and yet the valve must open and close easily. Furthermore, if the valves are installed in dangerous or inaccessible locations, shutting down the equipment for repairs on a valve or replacement of a valve seat may be extremely costly. The valve seats must, therefore, be constructed to withstand long wear without leaking.
>
> The principal object of this invention is to produce a valve seat construction which provides maximum security against leakage, which reduces wear on the seats to a minimum, and which ensures smooth opening and closing of the valves. Another object is to provide a seat construction with [*sic*] is adapted not only for seats made of the flexible rubber-like materials ordinarily used, but also for seats made of hard plastics or even metals, where extreme temperature or load conditions preclude the use of rubber-like materials.
>
> The valve here disclosed includes a ball, a valve casing, a stem for controlling the ball, and a bonnet, all of which may be of generally conventional construction. Preferably a pair of sealing rings, one on the upstream side and one on the downstream side of the ball, are employed as the sealing elements. These rings have lips which are free to deflect to a greater or less extent, depending on the seat material and the load conditions, and which are shaped and proportioned in such a manner as to engage the ball at an angle with respect to the direction of the flow. Furthermore, both the port of the ball and the lips have rounded rims disposed in a specific relationship, as will be later described in detail so that the edge of the port cannot cut into the lip when the valve is being opened or closed. Other advantages and novel features of the valve will be apparent from the description which follows.

this problem is that "[i]t is essential to form a perfectly tight seal between the ball and the seat, usually on both the upstream and downstream side," while at the same time permitting the valve to "open and close easily." The preamble states that the principal object of the invention is "to produce a valve seat construction which provides maximum security against leakage, which reduces wear on the seats to a minimum, and which ensures smooth opening and closing of the valves." To achieve this purpose, the ball and valve "may be of generally conventional construction." They are to be used, however, in combination with the new sealing element. The seal, which is given a more technical description in claims 7 and 8, has a lip which remains in constant contact with the ball, which may flex to permit rotation and reduce wear, but which is so constructed and placed that it remains tight against the surface of the ball at all times.

The District Court did not reach the question whether the sealing element, considered in isolation, had enough novelty to be patentable. Instead, it addressed itself to the question whether by claiming patentability for the valve, ball and seal, in combination, the plaintiff had overclaimed and hence forfeited ~~his~~ the claim to patentability.

The same patent was in suit in *Jamesbury Corp.* v. *United States, supra.*[6] The Court of Claims adopted the trial opinions of then Commissioner Lane and Trial Judge Colaianni. The first of these opinions held that Jamesbury's ball valve, with its new seal, "solved problems of temperature variation, pressure variation, and valve wear" which had been inherent in prior art. *Id.*, 518 F.2d at 1387. Solution of these problems was made possible by employment

6 The case found its way to the Court of Claims because the United States was a defendant. The patentee contended that valves used in Navy submarines infringed its patent.

of "a novel sealing ring utilizing a principle different from . . . compression sealing rings" known to prior art. *Id.* The importance of the innovation is emphasized by reference to the Jamesbury valve's striking commercial success. *Id.*[7] The second opinion by Judge Colaianni upheld the patent against a claim of anticipation by prior art patents. *Id.* at 1398-99.

In rendering summary judgment for appellees, Judge Blumenfeld does not appear to have taken issue with the novelty of the sealing ring itself.[8] Instead, perceiving that claims 7 and 8 distinctly extend to the ball and valve casing as well as the seal, he treated the patent as an attempt to claim a combination of elements: a ball, a valve, and—by virtue of improvement in a single element of the ball valve—a sealing ring. *Cf. Lincoln Engineering Co.* v. *Stewart-Warner Corp., supra; Bassick Mfg. Co.* v. *R.M. Hollingshead Co.,* 298 U.S. 415 (1936). *Holstensson* v. *V-M Corp.,* 325 F.2d 109 (6th Cir. 1963), *cert. denied,* 377 U.S. 966 (1964).

The District Court applied the test for combination patents advanced by *Lincoln Engineering, supra,* 303 U.S. at 549, which purportedly requires disclosure of a "new function". The District Court found that no new function was disclosed:

> There is nothing to indicate that a ball valve incorporating the new seal performs any "additional or different function" than other ball valves. It does not function in a new manner. It may be more efficient or durable, but it does what ball valves have always done.

---

7 The court also noted that "[p]rior to the development of the plaintiff's patented valve, ball valves were not generally accepted or used by industry." *Id.* at 1386.

8 The opinion below is reported at 442 F. Supp. 266.

> *Cf. Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950). Even the use of a seat/seal in a ball valve was not new. . . . The patentee may have invented a seat and seal suitable for use in a ball valve, but there is not the slightest doubt that the plaintiff did not invent a ball valve.

442 F. Supp. at 267-68. The court thus rejected appellant's contention that patentability can be based on an "improved result," as well as the contention that this combination performs a novel *sealing* function. Although the Judge intimated that the sealing ring itself might have been patentable, he found the claim for the combination, with the conventional elements added, to be fatally overbroad. On this view of the case, the court held, quite properly that if the claims were, indeed, overbroad, resort could not be had to the specifications in an attempt to limit the patent to its single novel element. *See Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 277 (1949); *cf. Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 149 (1950). Claims 7 and 8 were therefore declared invalid in their *entirety*. The court thus found the patent invalid for overclaiming. The District Court excluded from consideration the earlier decision of the Court of Claims upholding the validity of the same patent, because it believed that the issue of overclaiming had not been presented to the Court of Claims.

Subsequent events indicate that the District Court may have been unwittingly in error when it made that assumption. A memorandum of the Court of Claims in *Jamesbury* v. *United States, supra,* Nos. 189-63; 520-71 (June 2, 1978) after Judge Blumenfeld's decision, states that the issue of overclaiming *was* raised in that case and was rejected, without discussion. Because the present case in-

volves a different defendant and is before a different court, the earlier decision on the issue of overclaiming is neither "law of the case" nor binding precedent in this circuit. Nonetheless, we think that the contrary decision of the Court of Claims should give us pause in considering the propriety of a summary judgment in favor of the opponent of the same patent.[9]

The issue in this case is a narrow one. We do not believe that it concerns an attempt to patent a combination, *all* the elements of which are old. *See Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 282 (1976); *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* 340 U.S. at 151-53 (1950). *See also Anderson's Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57, 59 (1969) ("Each of the elements combined in the patent was known in the prior art."). Nor does it involve a patent where the interrelationship of the elements is a matter of convenience rather than necessity, and where each element could adequately perform its designed function in isolation. *See Anderson's Black Rock, Inc.* v. *Pavement Salvage Co., supra,* 396 U.S. at 60. Instead, we have a combination with one element, the seal, which is distinctly novel but which is "capable of serving no useful function alone." *Rosen* v. *Lawson-Hemphill, Inc.* 549 F.2d 205, 209 n.2 (1st Cir. 1976). As a matter of utility, the novelty lies in the very combination of valve, ball and sealing ring.

---

9 Incidentally, if we were to affirm the District Court, appellant presumably would be estopped from suing any other infringer under *Blonder-Tongue Laboratories* v. *University Foundation*, 402 U.S. 313 (1971), even though there would then be one decision in favor of the validity of the patent and one decision against—a tie score. *See Blumcraft of Pittsburgh* v. *Kawneer Co.*, 482 F.2d 542 (5th Cir. 1973). We need not confront this anomaly at this time, however, since we are constrained to reverse the summary judgment.

If we were to apply the premise of the District Court, its reasoning would be unassailable. We think, however, that the District Court adopted an unduly restrictive test for the patentability of a combination of this type. Starting with what we think to be the proper standard, we find the disclosures of claims 7 and 8 to be well within the zone of patentability.[10] We therefore reverse the summary judgment and remand for trial or other disposition.

The overclaiming defense advanced by the appellee rests almost exclusively on a purported analogy between appellant's patent and the patent invalidated by the Supreme Court in *Lincoln Engineering Co.* v. *Stewart-Warner Corp., supra.* That case involved a suit for *contributory* infringement against a *supplier* of an *old* element which was included in the claim of the alleged combination patent. The patent claimed a combination of a grease gun, hose, coupler and fitting of the type commonly used for packing wheel bearings. All the elements, as well as their use in combination, were known to the art. The only novelty stemmed from improvements in the "chuck" or coupler that utilized fluid pressure to "cock" the jaws of the coupler after each operation. The basic structure of even the "chuck" remained conventional, however. The Supreme Court held that the minor improvement in the coupler did not justify a claim embracing the entire mechanism. "[T]he improvement of any one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function *in* the combination." 303 U.S. at 459 (emphasis added).

---

10 35 U.S.C. § 101 provides in part:

Whoever invents or discovers . . . any new or useful improvement [of "process, machine manufacture or composition of matter"] may obtain a patent therefor. . . .

Concededly, there is a surface analogy between *Lincoln Engineering* and the present case. As the Judge recognized, the basic combination of the ball, valve, and seal is well-known. And it is true also that the appellant's patent does claim the entire combination on the basis of its development of only an improved sealing ring. But these surface similarities do not, in our opinion, warrant a rigid application of *Lincoln Engineering's* "new function" test. Analogy between that case and this one breaks down because here, instead of a minor improvement, we have a major innovation in the ball valve art, and particularly because there is no utility in the innovation except as part of the combination.

The Court in *Lincoln Engineering* did not elaborate on its definition of a "new function". Nor do we read the phrase as a formula, susceptible of categorical application. In *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* 340 U.S. at 150, the Court noted that it "has never ventured to give a precise and comprehensive definition of the test to be applied" to combination patents. One must probe beyond any single case, and regard each case in the light of the particular claims of patentability.

Lincoln Engineering in particular must be read together with the Court's treatment of the same issue in *Williams Co.* v. *United Shoe Machinery Corp.,* 316 U.S. 364 (1942). In an opinion for the Court, Justice Roberts, who had also written *Lincoln Engineering,* upheld combination patents for improvements in heel lasting machines. The improvements enabled automatic "wiping" and "tacking" functions, which had been disclosed by prior patents, to be performed by the same machine for shoes in a wide range of sizes. The Court affirmed the determination of the courts below "that each combination exhibits invention in that its elements coöperate in a new and useful way to accomplish

an improved result" (emphasis added). *Id.* at 368. Justice Roberts distinguished *Lincoln Engineering* on two grounds. First, it had involved a suit against an alleged contributory infringer who had merely supplied one of the conventional, *unimproved* elements. *Id.* at 370. Second, the patent in *Lincoln Engineering* had claimed an entire device, while in *Williams* "[t]he present suit for infringement is not for the use of an automatic bed lasting machine as such," *id.;* instead "each of the claims is confined to a combination of specified means applicable only to a restricted portion and function of the whole machine," *id.* at 368. *Williams* holds that, where an invention achieves a marked improvement in the art, the test for patentability permits consideration of the improved results as a factor. The invention was patentable, even though the combination of elements did not involve a different operation or cause the machine to serve a different purpose. The lasting machine still wiped and tacked as before. But the patented combination did achieve a new result—use of the same machine for a wide variety of shoe sizes. It thereby significantly enhanced the usefulness of the automatic heel lasting device, and solved an important problem for the shoe manufacturing industry. All the elements claimed in the patent cooperated to accomplish the result. Hence, the combination was patentable.

Authority in this and other circuits lends strong support to that interpretation as the prevailing standard. In *Guide* v. *Desperak,* 249 F.2d 145 (2d Cir. 1957), this court held that a combination claim may be patentable if it discloses a "new and useful result." *Id.* at 147. *See also Parks* v. *Booth,* 102 U.S. 96, 102 (1880). *Guide* involved a device for spirally stitching preformed hemispherical cups for brassieres. The claimed combination contained a single new element, a U-shaped workholder. The patent was ultimately

rejected on grounds of obviousness, but the court found no defect in the inclusion of conventional elements in the patent claim, because the combination achieved the useful result of allowing the cups to be preformed prior to stitching.

To the same effect are the decisions of the First Circuit in *Rosen* v *Lawson-Hemphill, Inc., supra,* and of the Seventh Circuit in *Reese* v. *Elkhart Welding & Boiler Works, Inc.,* 447 F.2d 517 (7th Cir. 1971). *Rosen* involved a combination claim for a device designed to supply thread at low and constant tension for pattern knitting mills, in answer to a problem that had long plagued the industry. A defense of overclaiming was raised by the defendant in an infringement action, on the ground that the patent claimed an entire yarn storing device, whereas the single novel element was a tension retarding ring. Chief Judge Pettine rejected the defense, because the ring "has no utility standing alone" and "as part of the combination . . . it cooperates in such a way . . . as to improve the operation of the combination, thus producing a new and unusually beneficial result which was not previously obtained nor was it obvious." 399 F. Supp. 532, 538-39 (D.R.I. 1975). Although old elements were employed, there was a "marked improvement over prior art" sufficient to warrant patentability. *Id.* The Court of Appeals summarily affirmed Judge Pettine's analysis. 549 F.2d at 208-09 & n.2.[11]

The *Reese* case involved a patent for improvements in auto-trailer hitches. The court stated as the applicable rule

---

11 There is no evidence in *Rosen*, as appellant suggests, that the court relied on a *Jepson*-type of claiming, *Ex parte Jepson*, 1917 C.D. 62, 248 O.G. 526, where the conventional elements are set forth in the preamble and the novel element is set forth in the body of the claim. *See Application of Simmons*, 312 F.2d 821, 50 C.C.P.A. 990 (1963).

of law "that a novel combination of elements, whether all new, or all old, or partly old, which so cooperate as to produce a new and useful result or substantial increase in efficiency is patentable." *Reese* v. *Elkhart Welding & Boiler Works, Inc., supra,* 447 F.2d at 523. The court found a new result in the hitch's increased resistance to sway during hauling, which solved a major problem encountered by hitches in the prior art. *See also Pursche* v. *Atlas Scraper and Engineering Co.,* 300 F.2d 467 (9th Cir. 1962) (more efficient plow).

These cases point the way. A combination claim containing elements old in the art may be patented, not only when it discloses a "new function" within the meaning of *Lincoln Engineering, supra,* but also when, by *cooperation* of the elements claimed, it discloses a new result that represents a marked improvement over prior art.[12]

The District Court thought that *Holstensson* v. *V-M Corp., supra,* looked the other way and supported its conclusion that the plaintiff had overclaimed.[13] We do not agree. *Holstensson* involved a patent that claimed both a phonograph spindle and a cycling device, which in combination permitted several records to be played automatically in series. The cycling element was entirely old in the art, having been disclosed by a prior patent of the same inventors.[14] The spindle mechanism, though preceded by prior art spindles accomplishing similar functions, em-

12 The rule stated in text also draws support from scholarly authority. *See* 1 Robinson on Patents, §§ 154, 155, 156.

13 The District Court also relied on *Trico Prods. Corp.* v. *Robert Co.,* 490 F.2d 1280 (2d Cir. 1973), *cert. denied,* 417 U.S. 933 (1974), a case also decided at the district level by Judge Blumenfeld. We note, however, that the decision was affirmed on appeal only on the ground of obviousness. *Id.* at 1281.

14 Moreover, unlike the present case, the conventional character of the cycling element was not identified by the specifications. *Id.* at 113.

bodied improvements in design that permitted activation by a lever placed beneath the phonograph turntable. Although the patent specifications indicated that the invention was addressed to the problem of playing records of various sizes in series, and several other patent claims were directed to this purpose, the court held that the single claim in issue did *not* disclose such a function, and it specifically excluded arguments based on that function in assessing the validity of the combination claim. *Id.*, 325 F.2d at 113, 121. The only novelty thus consisted in improvements in the operation of the spindle itself. The court held that to be patentable *as part of the combination,* the old elements must "contribute something more than mere presence, to the functioning, the utility and the novelty claimed to provide the patentability for the total combination." *Id.* at 120. By this standard, the patent was invalid, because the invention "resided only in the spindle device" and the cycling mechanism "contributed no more to the operation of the claimed combination than the electric motor which provided the power for rotating the turntable." *Id.*

In our view, the decisive factor in *Holstensson* is the court's initial premise concerning the disclosure of the claim. Once the novel function of playing various-sized records was excluded for purposes of testing the validity of the claim, it was clear that the elements in the combination did not *cooperate* to produce the only new result, the improved operation of the spindle. The spindle could perform its operation alone, whether the cycling mechanism was present or not. In the court's view, the cycling mechanism added nothing more than presence to the achievement of the intended result.

Moreover, we think that the addition of the elements of ball and valve to the novel sealing ring narrowed rather

than broadened the claims. The aphorism that "in a patent claim, more means less" is true here. Jamesbury is not attempting to prevent others from using *any* ball valve but is attempting to prevent others from using only a ball valve with a sealing ring like theirs. *See Williams Mfg. Co.* v. *United Shoe Machinery Corp., supra,* 316 U.S. at 370-71; *see also International Latex Corp.* v. *Warner Brothers Co.,* 276 F.2d 557, 562 (2d Cir.), *cert. denied,* 364 U.S. 816 (1960). A claim for direct infringement would lie *only* against one who infringes a ball valve containing the specified sealing ring. *Guide* v. *Desperak, supra,* 249 F.2d at 147.

Of course, that limitation might not apply to a *contributory* infringer, who manufactured a conventional valve or ball which the direct infringer then combined with an infringing sealing ring to make an entire infringing device. If such a contributory infringer were to be held liable, there would be an argument on policy that the claim was unfairly overbroad. We are not dealing here with such a contributory infringer, and older cases, including *Lincoln Engineering, supra,* in which *contributory* infringers were suppliers of conventional elements, must be read with that distinction in mind. When we juxtapose *Williams, supra,* a direct infringement case, with *Lincoln Engineering,* one gets the impression that the nature of the claimed infringement, though not the sole basis for decision, substantially affected the result. We need not go so far as the Patent and Trademark Office Board of Appeals has gone in ruling that, since it is now a defense to contributory infringement that a product is capable of substantial non-infringing use, 35 U.S.C. § 271(c), statutory amendments may have deprived *Lincoln Engineering* of force on its own ground. ***Ex parte Barber,*** 187 U.S.P.Q. (BNA) 244 (1974). We find it unnecessary to determine

whether we agree with the suggestion in that opinion that *Lincoln Engineering* has been legislatively overruled, but we do find that subsequent history militates against an expansive application of the Court's reasoning in *Lincoln Engineering*.

Since we reject overclaiming as a self-evident defense, we must reverse the summary judgment. We will not, however, order a grant of summary judgment in favor of Jamesbury. The factual question remains whether the patent accomplishes a new result which is achieved by the elements working in cooperation—the prevention of leakage caused by temperature variation, pressure variation or valve wear. Appellant has submitted an affidavit of its president dealing with the question. Appellee may have some factual evidence in contradiction. While we remand for trial, we are not ruling out a partial summary judgment on validity in favor of appellant, if no question emerges on the issues of novelty or obviousness. The infringement question, if contested, is reserved for trial or other disposition.[15]

Reversed and remanded.

---

15 We note that the patent in suit has apparently expired, but the issue of damages for past infringement remains, in any event. We express no opinion on the proper measure of damages if the District Court reaches the issue.

530—10-24-78 • USCA—4391

RECORD PRESS, INC., 95 MORTON ST., NEW YORK, N. Y. 10014, (212) 243-5775

Supreme Court, U. S.
FILED
FEB 15 1979
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-1149

JAMESBURY CORPORATION, *Respondent,*

v.

LITTON INDUSTRIAL PRODUCTS, INC.,
Petitioner.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

ROBERT C. MILLER
1755 S. Jefferson Davis Highway
Arlington, Virginia 22202
Attorney for Respondent

Of Counsel:

ARTHUR I. NEUSTADT
OBLON, FISHER, SPIVAK, MCCLELLAND & MAIER, P.C.
1755 S. Jefferson Davis Highway
Arlington, Virginia 22202

J. READ MURPHY
MURTHA, CULLINA, RICHTER AND PINNEY
101 Pearl Street
Hartford, Connecticut 06103

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

TABLE OF CONTENTS

Page

THE QUESTION PRESENTED BY PETITIONER 1

STATEMENT OF THE CASE 2

ARGUMENT 5

There is No Conflict Among the Circuits 5

The Overclaiming Evil Found in *Lincoln Engineering* is Absent in the Case At Bar 7

CONCLUSION 11

Page

STATUTE:

35 U.S.C. 271(c) 7

RULE:

Rule 19(1)(b), Rules of the Supreme Court of the United States 1, 2, 5

CASES:

American Safety Table Company v. Schreiber, 415 F.2d 373 (2d Cir. 1969) 9

Bassick Mfg. Co. v. R. M. Hollingshead, Co., 298 U.S. 415 (1936) 10

Crosby Steam-Gage & V. Co. v. Consolidated Safety-Valve Co., 141 U.S. 441 (1891) 9

Deepsouth Packing Co. v. Laitram Corp., 406 U.S. 518 (1972) 8

Duplan Corp. v. Deering-Milliken, Inc., 444 F. Supp. 648 (D.S.C. 1977) 2, 6, 7

Guide v. Desperak, 249 F.2d 145 (2d Cir. 1957) 4, 6

Holstensson v. V-M Corp., 325 F.2d 109 (6th Cir. 1963) 6

Jamesbury Corp. v. United States, 518 F.2d 1384 (Ct. Cl. 1975) 2, 3

Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545 (1938) 3, 4, 5, 6, 7, 10

Pursche v. Atlas Scraper and Engineering Co., 300 F.2d 467 (9th Cir. 1962) 4, 6

Reese v. Elkhart Welding & Boiler Works, Inc., 447 F.2d 517 (7th Cir. 1971) 4, 6

Rosen v. Lawson-Hemphill, Inc., 549 F.2d 205 (1st Cir. 1976) 4, 6

Williams Co. v. United Shoe Machinery Corp., 316 U.S. 364 (1942) 4, 5, 6, 10

IN THE

Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-1149

JAMESBURY CORPORATION, *Respondent,*

v.

LITTON INDUSTRIAL PRODUCTS, INC., *Petitioner.*

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

THE QUESTION PRESENTED BY PETITIONER

Searching for a Rule 19 pigeonhole in which to lodge, petitioner has cast aside both facts and law in order to arrive at its predetermined destination—"a conflict among the circuits."

No such conflict exists.

The decision by Judge Gurfein speaking for a unanimous panel of the U.S. Court of Appeals for the Second Circuit, as appears in the decision itself [1], is in harmony with what petitioner has characterized as "the rule in the Sixth Circuit." Further, the decision by the Second Circuit is in harmony with petitioner's "Fourth Circuit" decision which, in fact, is not a

[1] Appendix at A18-A19.

decision by a court of appeals as required by Rule 19(1)(b), but is a district court decision.[2]

STATEMENT OF THE CASE

The patent in suit is directed to the Jamesbury ball valve, a pioneer invention which the Second Circuit described as

> a major innovation in the ball valve art[3]

The Jamesbury patent was previously adjudicated in the U.S. Court of Claims as a result of the extensive employment of the Jamesbury invention in the U.S. nuclear submarine fleet. In holding the patent valid, the Court noted the invaluable contribution made by Jamesbury's invention.

> Increased size and better hull construction enable the modern submarine to navigate at greater depths. Valves must operate under greatly increased pressure, be able to withstand hydraulic shock caused by depth charges, permit fluids to flow silently, work under problems of corrosion and erosion with sea water, and be remotely operable. No other valve in industry or in prior submarine service except the plaintiff's [Jamesbury's] valves solved all of these problems.[4]

The pioneer status of the Jamesbury invention is also evident from its acceptance by industry. As noted by the Court of Claims and by the Second Circuit,

---

[2] *Duplan Corp.* v. *Deering-Milliken, Inc.*, 444 F. Supp. 648 (D.S.C. 1977).

[3] Appendix at A15.

[4] *Jamesbury Corp.* v. *United States*, 518 F.2d 1384, 1387 (Ct. Cl. 1975).

> Prior to the development of the plaintiff's patented valve, ball valves were not generally accepted or used by industry.[5]

Despite the decision by the Court of Claims, the Connecticut District Court, after expressing surprise at an earlier hearing that any ball valve could be patentable,[6] held the Jamesbury patent to be invalid on its face[7] and rendered summary judgment against Jamesbury.

The Connecticut District Court seized upon the following language from *Lincoln Engineering* in support of its conclusion: "the improvement of any one part of an old combination gives no right to claim that improvement in combination with other old parts which

---

[5] *Id.* at 1386; Appendix at A8 and A11, n.7.

[6] Mr. Neustadt: The patentee is Jamesbury and the patent relates to a ball valve.

> I don't know whether your Honor is familiar with it, but it's a pretty basic ball valve [patent] that was already litigated and was adjudicated valid and infringed by the Court of Claims.
>
> The Court: Really? A ball valve?
>
> Mr. Neustadt: Yes.
>
> The Court: Adjudged valid?
>
> Mr. Neustadt: Yes, your Honor.
>
> The Court: The Court of Claims?
>
> Mr. Neustadt: Yes, your Honor.
>
> The Court: How long ago was that?
>
> Mr. Neustadt: The decision became final in October of '75.
>
> The Court: Pretty clever patent lawyers, I guess.
>
> But I haven't read the case, so I shouldn't be facetious.

[7] No affidavit or other evidence was submitted by petitioner in support of its motion for summary judgment.—Appendix at A7, n.1.

perform no new function in the combination."[8] The District Court reasoned that there could be no "new function" because, after all, the Jamesbury ball valve was still a ball valve. That the Jamesbury ball valve was an operational success in contrast to prior art ball valves which were not generally accepted by industry was dismissed as merely showing that the Jamesbury ball valve was "more efficient."[9] It is doubtful whether any invention, no matter how meritorious, could pass this test.

The Second Circuit reversed on the basis that an "improved result"[10] such as the new sealing function achieved by the Jamesbury ball valve was not excluded by the definition of "new function" set forth in *Lincoln Engineering*.

In its decision, the Second Circuit noted that this was not a case of first impression; that it was merely following established precedent in this Court which interpreted *Lincoln Engineering* in this manner;[11] and that other courts of appeal were in agreement.[12] The Second Circuit noted no conflict among the circuits and even found that the Sixth Circuit decision relied

---

[8] Appendix at A2.

[9] Appendix at A3.

[10] Appendix at A16.

[11] *Williams Co.* v. *United Shoe Machinery Corp.*, 316 U.S. 364 (1942); Appendix at A15-A16.

[12] *Guide* v. *Desperak*, 249 F.2d 145 (2d Cir. 1957); *Rosen* v. *Lawson-Hemphill, Inc.*, 549 F.2d 205 (1st Cir. 1976); *Reese* v. *Elkhart Welding & Boiler Works, Inc.*, 447 F.2d 517 (7th Cir. 1971); *Pursche* v. *Atlas Scraper and Engineering Co.*, 300 F.2d 467 (9th Cir. 1962), *cert. denied*, 371 U.S. 911 (1962); Appendix at A16-18.

upon by the Connecticut District Court and by petitioner was not in disagreement.[13]

ARGUMENT

There Is No Conflict Among the Circuits

The "direct infringement-contributory infringement" conflict among the circuits proposed by petitioner is an illusion concocted to mate with the requirements of Rule 19(1)(b). Reality is to the contrary.

Petitioner points to no portion of the Second Circuit's decision which holds that *Lincoln Engineering* is limited to contributory infringement situations. In fact, the Second Circuit distinguished *Lincoln Engineering* on another basis.

> Analogy between that case [*Lincoln Engineering*] and this one breaks down because here, instead of a minor improvement, we have a major innovation in the ball valve art, and particularly because there is no utility in the innovation except as part of the combination.[14]

The inescapable fact remains that the Second Circuit merely followed applicable law of this Court and other courts of appeal that an "improved result" is not excluded by the "new function" language of *Lincoln Engineering*.

As stated by this Court and as cited by the Second Circuit in support of its decision,

> each combination exhibits invention in that its elements cooperate in a new and useful way to

---

[13] "The District Court thought that *Holstensson* v. *V-M Corp.*, *supra*, looked the other way and supported its conclusion that the plaintiff had overclaimed. We do not agree."—Appendix at A18.

[14] Appendix at A15.

accomplish *an improved result* [15] (emphasis by Second Circuit)

The Courts of Appeal for the First [16], Second [17], Seventh [18] and Ninth [19] Circuits have used similar language in explaining *Lincoln Engineering.*

As explained by the Second Circuit, petitioner's Sixth Circuit decision, *Holstensson* v. *V-M Corp.,* did not look "the other way" [20] because, in *Holstensson,* the asserted "new and improved result" of playing records of various sizes in series was not set forth or disclosed in the single claim in issue and, therefore, could not be relied upon to show validity. This, as stated by the Second Circuit, was the "decisive factor" [21] in *Holstensson.*

The only other decision cited by petitioner in support of its conclusion of conflict among the circuits is *Duplan Corp.* v. *Deering-Milliken, Inc.*[22], a district court decision and not a decision by a court of appeals. Further, *Duplan* is not in disagreement with the decision reached by the Second Circuit in this case because, in *Duplan,* the invention was found to be obvious [23] and, therefore, there was no "new and improved result."

[15] *Williams Co.* v. *United Shoe Machinery Corp.,* 316 U.S. 364, 368 (1942); Appendix at A15-A16.

[16] "useful, novel and nonobvious"—*Rosen* v. *Lawson Hemphill, Inc.,* 549 F.2d 205, 209, n.2 (1st Cir. 1976); Appendix at A17.

[17] "new and useful result"—*Guide* v. *Desperak,* 249 F.2d 145, 147 (2d Cir. 1957); Appendix at A16-A17.

[18] "new and useful result or substantial increase in efficiency"—*Reese* v. *Elkhart Welding & Boiler Works, Inc.,* 447 F.2d 517, 523 (7th Cir. 1971); Appendix at A17-A18.

[19] "new and useful result"—*Pursche* v. *Atlas Scraper and Engineering Co.,* 300 F.2d 467, 477 (9th Cir. 1962), *cert. denied,* 371 U.S. 911 (1962); Appendix at A18.

[20] Appendix at A18.

[21] Appendix at A19.

[22] 444 F. Supp. 648 (D.S.C. 1977).

The Overclaiming Evil Found in *Lincoln Engineering* is Absent in the Case at Bar

As explained by the Second Circuit,[24] in *Lincoln Engineering,* the patent claim was directed to a combination of old elements and a coupler whose basic structure was conventional but which did include a minor improvement. The patentee in *Lincoln Engineering* sought to hold as a contributory infringer a supplier who supplied, not the coupler with its minor improvement, but, one of the old elements. Under these circumstances, this Court found this to constitute "overclaiming".[25]

In contrast, in the case at bar, as noted by the Second Circuit, Jamesbury is not seeking to hold petitioner liable for supplying an old element such as "a conventional valve [casing] or ball." [26] Petitioner would like

[23] "The court has concluded that the patent is void for obviousness under this statute."—*Id.* at 718.

[24] Appendix at A14.

[25] Under the 1952 patent act, enacted subsequent to *Lincoln Engineering,* it appears that the same denial of recovery would occur, but the basis would be lack of infringement (rather than patent invalidity) because the old element would not be "especially made" for infringement of the patent pursuant to 35 U.S.C. 271 (c). The Second Circuit noted this possibility at A20-A21 but declined to make a specific holding with respect thereto since it found that the "major innovation" of the Jamesbury ball valve was not excluded by the "new function" requirement of *Lincoln Engineering.*

[26] Appendix at A20.

to be treated as if this were the case, but, the inescapable fact remains that petitioner makes the entire patented ball valve.

In fact, rather than "overclaim", Jamesbury actually obtained less patent protection with the inclusion of more elements in its claims because, in a patent claim, more is less.[27]

As stated by the Second Circuit

> Moreover, we think that the addition of the elements of ball and valve [casing] to the novel sealing ring narrowed rather than broadened the claims. The aphorism that "in a patent claim, more means less" is true here.[28]

Petitioner did not dispute this aphorism before the District Court or before the Second Circuit but, rather, in order to impute a sinister motive to Jamesbury, asserted that the patent claims were drafted to secure a larger royalty base, it being petitioner's unstated assumption that the royalty base was dependent upon the patent claim. Petitioner cited no authority for this proposition and, indeed, it could not because authority is to the contrary.

Since market conditions play such a large part in quantifying a reasonable royalty, it has long been the law that the royalty should be based on the commercial article sold if the article owes its value to its patented feature irrespective of the fact that the commercial

[27] " 'if anything is well settled in the patent law, it is that the combination patent covers only the totality of the elements in the claim and that no element, separately viewed, is within the grant.' Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S., at 344, 81 S.Ct., at 604."—*Deepsouth Packing Co.* v. *Laitram Corporation*, 406 U.S. 518, 528 (1972).

[28] Appendix at A20.

article may include elements which are not recited in the claims of the patent. This is often referred to as the "entire value" rule. As stated by this Court,

> It appearing that the defendant's valve derived its entire value from the use of the Richardson invention covered by the patent of 1866, and that the entire value of the defendant's valve, as a marketable article, was properly and legally attributable in that invention of Richardson, the plaintiff is entitled to recover the entire profit of the manufacture and sale of the valves.[29]

This rule has been followed.

> The facts and circumstances of this case come under the rule that where the entire marketable value of the thing sold is dependent on the patent, its entire value is included in computing infringement damages.[30]

In addition, since market conditions dictate that an invention is worth a certain sum in the marketplace, it matters not whether the sum is computed as a small percentage of a large base or as a large percentage of a small base.

Since this matter is so far afield of the issue of patent validity, neither the District Court nor the Second Circuit considered it in their opinions, although Judge Oakes during oral argument summarily dismissed it as merely relating to damages, not validity.

[29] *Crosby Steam-Gage & V. Co.* v. *Consolidated Safety-Valve Co.*, 141 U.S. 441, 454 (1891).

[30] *American Safety Table Company* v. *Schreiber*, 415 F.2d 373, 377 (2d Cir. 1969), *cert. denied*, 396 U.S. 1038 (1970).

Further, this Court in *Williams Co.* v. *United Shoe Machinery Corp.*[31] recognized that the overclaiming evil present in *Lincoln Engineering* and *Bassick*[32] is not present in a direct infringement situation and dismissed *Lincoln Engineering* and *Bassick* with the language "Those were suits for contributory infringement." As stated by this Court,

> The petitioner, however, contends that the breadth of the claims in suit is such that, instead of patenting the combinations claimed as improvements over the prior art, and restricting the claims to the improvements, the patentee sought to blanket every machine which combines the old bed laster with the equally old automatic tacking device. It is said that our decision in Bassick Mfg. Co. v. R. M. Hollingshead Co., 298 U.S. 415, 56 S.Ct. 787, 80 L.Ed. 1251; and Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545, 58 S.Ct. 662, 82 L.Ed. 1008, forbid any such extension of the patent monopoly. . . . Bassick Mfg. Co. v. R. M. Hollingshead Co., supra, and Lincoln Engineering Co. v. Stewart-Warner Corp., supra, lend no support to the petitioner's argument. *Those were suits for contributory infringement.*[33] (emphasis added)

[31] 316 U.S. 364 (1942).

[32] *Bassick Mfg. Co.* v. *R. M. Hollingshead Co.*, 298 U.S. 415 (1936).

[33] *Williams Co.* v. *United Shoe Machinery Corp.*, 316 U.S. 364, 368-370 (1942).

CONCLUSION

There being no conflict among the circuits as asserted by petitioner and the case being rightly decided by the U.S. Court of Appeals for the Second Circuit, the petition should be denied.

ROBERT C. MILLER
1755 S. Jefferson Davis Highway
Arlington, Virginia 22202

Attorney for Respondent

Of Counsel:

ARTHUR I. NEUSTADT
OBLON, FISHER, SPIVAK, MCCLELLAND & MAIER, P.C.
1755 S. Jefferson Davis Highway
Arlington, Virginia 22202

J. READ MURPHY
MURTHA, CULLINA, RICHTER AND PINNEY
101 Pearl Street
Hartford, Connecticut 06103